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Paper No. 24

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SEP 22 2003

OFFICE OF PETITIONS

David Andrew D'Zmura
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In re Application of
David Andrew D'Zmura
Application No. 09/849,582
Filed: May 5, 2001
Attorney Docket No.: None
Title: METHOD OF DETERMINING
ZODIAC SIGNS

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a)¹, filed September 8, 2003, to revive the above-identified application².

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due (notice), mailed June 2, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting issue fees³. Accordingly, the above-identified application became abandoned on September 3, 2003.

On September 8, 2003, petitioner filed the instant petitions. Petitioner has included the petition and issue fees⁴, and a statement of facts from the inventor.

1 A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

2 Petitioner concurrently filed a petition under 37 C.F.R. §1.137(b). This later petition will not be worked on at the present time, so as to afford the applicant another opportunity to submit a renewed petition under the unavoidable standard.

3 See MPEP §710.02(e).

4 The petition and issue fees (\$55 and \$650, respectively) have been charged to petitioner's credit card, as authorized in the petition.

The instant petition lacks item (3) above.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”⁵

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”⁶

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁷

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁸

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁹

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”¹⁰

5 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’s interpretation of a statute it administers is entitled to deference”); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”)

6 Commissariat A L’Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

7 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

8 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

9 Id.

10 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

Nonawareness of a PTO rule will not constitute unavoidable delay¹¹

The burden of showing the cause of the delay is on the person seeking to revive the application¹².

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action¹³.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present¹⁴.

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account¹⁵."

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable¹⁶."

The rule and portion of the MPEP relevant to the abandonment of this application

37 CFR 1.311. Notice of Allowance.

- (a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in 37 C.F.R. §1.33. The notice of allowance

¹¹ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

¹² Id.

¹³ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

¹⁴ In re Mattullath, 38 App. D.C. at (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

¹⁵ Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

¹⁶ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (37 C.F.R. § 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

710.02(e) Extension of Time

- (c) If an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability":
- (2) The period for submitting formal drawings set under 37 C.F.R. §1.85(c).

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore; petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner contends that the funds required to submit the issue fee were not available until after the expiration of the period of reply.

The statement of facts sets forth that when the applicant received the notice, he did not have the necessary funds in the forms of cash, his savings account, checking account, or credit cards. On August 16, 2003, petitioner attempted to sell his car to a dealership. Petitioner ended up purchasing a new car, leaving his old car at the dealer with instructions to return on August 21st to pick up a check for \$3,700. Petitioner returned as directed, only to have his new car repossessed by the dealer, and his old car returned to him. Obviously, the check in question was not provided to the applicant.

On September 4, 2003, petitioner managed to sell his car for \$3,500, and the instant petition was filed shortly thereafter.

Petitioner's argument has been considered, and has been deemed to be unpersuasive.

The petitioner has asserted financial difficulty in that he lacked the funds necessary to pay the issue fee. A showing of "unavoidable" delay based upon financial difficulty must establish that petitioner lacked the financial resources to pay the fee(s) associated with patent prosecution. Such a showing must be supported by a **complete and thorough** showing of his financial condition during the entire period between June 2, 2003 and September 8, 2003, including income, expenses, tax return statements, bank records, assets, credit and obligations, which made the delay in payment of the fee(s) unavoidable. Petitioner should provide copies of all documents or records pertaining to each of these so as to confirm the financial difficulty.

Consequently, the petition is **DISMISSED**.

The reply to this letter may be submitted by mail¹⁷, hand-delivery¹⁸, or facsimile¹⁹.

The application file will be retained in the Office of Petitions for two (2) months.

¹⁷ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

¹⁸ Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

¹⁹ (703) 308-6916, Attn: Office of Petitions.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.

A handwritten signature in black ink, appearing to read "Paul Shanowski". The signature is fluid and cursive, with the first name "Paul" being more prominent than the last name "Shanowski".

Paul Shanowski
Attorney
Office of Petitions
United States Patent and Trademark Office